

**REMARKS**

In accordance with the foregoing, claim 21 has been cancelled and claims 4,5,7,8, 9, 12, 18, 22-24 and 25 have been amended.

Claims 4-10,12-15 and 17-20, 22-26 are pending. No new matter is included in this Amendment.

**OBJECTION TO THE TITLE:**

The title of the invention is objected to as not being descriptive.

As noted above, the title of the invention has been amended to overcome the objection.

**OBJECTIONS UNDER 35. U.S.C. §112:**

Claims 5, 6, 9 and 10 are objected to as being informalities.

Claim 5 has been amended to overcome the objection.

In view of the above, it is respectfully submitted that the objection of claims 5, 6, 9 and 10 is overcome.

Claims 4-10 are rejected as being failed to comply with the written description requirement.

Claim 4 has been amended to overcome the rejection. Accordingly, it is respectfully submitted that the rejection of claims 4-10 be withdrawn.

**REJECTION UNDER 35 U.S.C. §102:**

Claims 4, 12, 14-15, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Eskey (U.S. Patent No. 6,649,874). This rejection is respectfully traversed.

Claim 21 is cancelled without prejudice or disclaimer.

The Office Action sets forth that Eskey discloses that a light to heat converting unit 24.

By way of review, Eskey discloses "the thermal spreader is fabricated from a material that preferably has low specific heat and high thermal spreader. Certain metals, such as copper and certain ceramic materials may be suitable for use as a thermal spreader" (col. 5, lines 49-53) However, Eskey fails to disclose "blackbody" as recited in claim 4.

Therefore, for at least the above, it is respectfully requested that this rejection of claim 4 be withdrawn. In addition, for similar rationale, it is respectfully submitted that claims 12, 14-15 are also in proper condition for allowance.

**REJECTION UNDER 35 U.S.C. § 103:**

Claims 7 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eskey (U.S. Patent No. 6,649,874) in view of Abe et al. (6,456,819). This rejection is respectfully traversed.

The outstanding Office Action acknowledges Eskey fails to disclose grease being applied between the heat converting unit and the film and the film being made of polyimide with a coating of PTFE. However, the Office Action sets forth Abe et al. teach an image fixing film 11 forming a nip therebetween so that toner images can be fixed to a recording medium. Grease is applied between the sliding surface and the film (col. 15, lines 44-55). The film is made from a polyimide with PTFE on the surface thereof (col. 16, lines 10-19). It would have been obvious to one of ordinary skill in the art at the time the invention was made to put grease between the heat converting unit and film of Eskey because sliding frictional resistance can be lessened. Further, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the film from polyimide and PTFE because the heat capacity can be made small which would improve the starting of the fixing device.

By way of review, Abe et al. discloses a heater having sliding surface but fails to disclose "blackbody" as recited in amended claim 7.

As a general matter, in order to establish a prima facie obviousness rejection, the Examiner needs to provide both the existence of individual elements corresponding to the recited limitations, and a motivation to combine the individual elements in order to create the recited invention. Both the individual elements and the motivation need to be shown to have existed in the prior art. Should the Examiner fail to provide evidence that either one of the individual elements or the motivation does not exist in the prior art, then the Examiner has not provided sufficient evidence to maintain a prima facie obviousness rejection of the claim. MPEP 2143.03. Thus, the burden is initially on the Examiner to provide evidence as to why one of ordinary skill in the art would have been motivated to combine the individual elements to create the recited invention, and to demonstrate that this evidence existed in the prior art.

As an example, MPEP 2143.03 refers to *In re Koltzab*, 55 USPQ2d 1313 (Fed. Cir. 2000). In *In re Koltzab*, the Federal Circuit agreed with the Patent Office and the Examiner that

the prior art, as a whole, disclosed each of the individual elements of the recited invention, which was an injection molding machine. However, the Federal Circuit held that “a rejection [for obviousness] cannot be predicated on the mere identification in [one of the prior art references] of individual components of the claimed limitations.” Instead, the Federal Circuit held that “particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.” Id. at 1317. As such, in order to establish a prima facie obviousness rejection of a claim, the Examiner needs to both provide this particular evidence of the motivation to make the combination, and show that this evidence existed in the prior art. MPEP 2141.03.

As mentioned above, it is respectfully submitted that none of the Eskey or Abe et al. patents, separately or combined, teach or suggest a fixing device comprising a thermal grease applied on an external surface of the blackbody as recited in amended claim 7. Accordingly, withdrawal of this rejection and allowance of independent amended claim 7 is earnestly solicited.

In addition, for at least a similar rationale, it is respectfully submitted that claim 13 is also in proper condition for allowance.

**OBJECTION TO THE CLAIMS:**

Claims 5-6, 8-10, 18-20 and 22-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

However, reconsideration of claims 5-6, 8-10, 18-20, and 22-26 is respectfully requested based upon the reasons mentioned above.

**CONCLUSION:**

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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